

REMARKS

Claims 1-43 and 45-61 were pending in the application. Claim 49 has been cancelled, without prejudice, and claims 1, 2, 15, 21, 22, 28, 37, 38, 48, 51, 58 and 59 have been amended. Accordingly, upon entry of the amendments presented herein, claims 1-43, 45-48, and 50-61 will remain pending.

Support for the amendments to the claims may be found throughout the specification and claims as originally filed.

Cancellation of and/or amendments to the claims as originally filed should in no way be construed as an acquiescence to any of the rejections/objections set forth in the instant Office Action, and were made solely to expedite prosecution of the above-identified application. Applicants reserve the right to pursue the claims as originally filed, or similar claims, in one or more patent applications. No new matter has been added.

Acknowledgement of Election

The Examiner has acknowledged the election of the *species* of SEQ ID NO:16 and has suggested that, in the interest of expediting prosecution, the remaining non-elected species be deleted from claims 28 and 37.

Accordingly, in the interest of expediting prosecution, Applicants have amended claims 28 and 37 to delete the non-elected sequences. However, it is the Applicants' understanding that under 35 U.S.C. §121, an election of a single species for prosecution on the merits is required, to which the claims will be restricted if no generic claim is finally held allowable. Applicants submit that at least claim 1 is generic. Applicants further understand that upon the allowance of a generic claim, they will be entitled to consideration of claims to additional species which are

written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R §1.141 *et seq.*

Objection to the Sequence Listing

The Examiner has objected to the sequence listing submitted on June 17, 2003 because the Sequence Listing was not accompanied by a statement that the Sequence Listing contains no new matter.

As required by 37 CFR §§1.825(a) and (b), Applicants hereby state that the Sequence Listing submitted on June 17, 2003 includes no new matter. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing objection to the Sequence Listing.

Objections to the Disclosure

The Examiner has further objected to the disclosure because of various informalities.

Applicants respectfully submit that the informalities noted by the Examiner, including the status of the parent application and the tables at page 43 of the specification, have been corrected, thereby rendering the foregoing objections moot. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw these objections to the disclosure.

Objection to Claim 20

The Examiner has objected to claim 20 as “being of improper dependent form for failing to further limit the subject matter of a previous claim.” Specifically, the Examiner indicates that “[d]ependent claim 20 recites that D can be a cyclic C₁₋₆ alkyl. However, claim 15, upon which claim 20 depends, does not indicate that D can be a cyclic alkyl.”

Applicants respectfully submit that claim 15 has been amended to indicate that, *inter alia*, D can be a cyclic alkyl, thereby rendering this objection moot. Accordingly, Applicants

respectfully request that the Examiner reconsider and withdraw the foregoing objection to claim 20.

Objection to Claims 1-28, 37, 38, 48, 53, 54, and 57-60

The Examiner has also objected to claims 1-28, 37, 38, 48, 53, 54, and 57-60 due to various informalities.

Applicants have amended these claims to correct the informalities noted by the Examiner, thereby rendering this objection moot. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing objection.

Objection to Claim 50

The Examiner has indicated that claim 50 will be objected to if claim 49 is found to be allowable.

In the interest of expediting prosecution, Applicants have cancelled claim 49, thereby rendering this potential objection moot.

Rejection of Claim 21 Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 21 under 35 U.S.C. § 112, second paragraph, as “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” In particular, the Examiner indicates that “[i]n claim 21, the word ‘and’ should be inserted before formula (IX) so that standard Markush terminology is used.”

Applicants respectfully submit that claim 21 has been amended as suggested by the Examiner, thereby rendering the foregoing rejection moot. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejection of Claims 1-43 and 45-61 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has rejected claims 1-43 and 45-61 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-52 of U.S. Patent No. 6,548,477. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '477 patent with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-43 and 45-61 of the present application are obvious over claims 1-52 of U.S. Patent No. 6,548,477, upon an indication of allowability of the instant claims, Applicants will consider submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Provisional Rejection of Claims 1-43 and 45-61 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-43 and 45-61 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-65 of co-pending Application No. 10/001,945. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '945 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-43 and 45-61 of the present application are obvious over claims 1-65 of co-pending Application No. 10/001,945, upon allowance of the '945 application, Applicants will consider submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Provisional Rejection of Claims 1-38 and 49-58 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-38 and 49-58 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-58, 60, 62 and 71-90 of co-pending Application No. 10/138,935. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '935 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-38 and 49-58 of the present application are obvious over claims 1-65 of co-pending Application No. 10/138,935, upon allowance of the '935 application, Applicants will consider submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

Provisional Rejection of Claims 1-43 and 45-61 Under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Examiner has provisionally rejected claims 1-43 and 45-61 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-73 of co-pending Application No. 10/429,174. In particular, the Examiner contends that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the claimed active agents of the '174 application with pharmaceutically acceptable carriers."

While in no way admitting that claims 1-43 and 45-61 of the present application are obvious over claims 1-73 of co-pending Application No. 10/429,174, upon allowance of the '174 application, Applicants will consider submitting a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) and (c), if appropriate, which will obviate this rejection.

CONCLUSION

In view of the foregoing remarks, reconsideration of the rejections and allowance of all pending claims is respectfully requested. If a telephone conversation with Applicants' Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 227-7400.

Applicant does not believe that any fee is due with this response. However, if any fees are due, please charge our Deposit Account No. 12-0080, under Order No. PPI-106CP from which the undersigned is authorized to draw.

Dated: July 9, 2004

Respectfully submitted,

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